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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,496	11/06/2003	Yutaka Tosaki	Q78309	7626
23373	7590	06/21/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/701,496	Applicant(s) TOSAKI ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/3/04; 11/6/03</u> | 6) <input type="checkbox"/> Other: ____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, each of these dependent claims recites a multilayer structure for the pressure sensitive adhesive layer(s) positioned on the substrate; however, it is noted that in claim 5, lines 11-18 the relationship between the outer layer and the pressure sensitive adhesive layer taken as a whole clearly overlap with respect to the amount of the anionic emulsifier which is required to be present in each layer. By so doing, of course, no layered structure is required to exist for these embodiments and as a result the claim is considered to be vague and indefinite. With respect to claim 6, the same relationship appears to exist with respect to the embodiment in which 3 parts per weight of the emulsifier is present, since the amount of the emulsifier in the outer layer and the amount of the emulsifier for the entire adhesive layer overlap and are thus identical for this particular amount. Clarification is requested.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran et al. Note particularly Examples 44-46, as well as column 1 lines 54-65, column 2 lines 29-41, column 5 lines 21-47, column 6 lines 18-28, line 65 - column 7 line 46, column 11 lines 5-34, column 20 line 5 - column 23 line 4. The reference discloses, in certain embodiments, substantially an anticipation of at least applicants' broad claim except for a specific recitation of the various amounts of such elements as the sulfur atom containing anionic emulsifier and hydrophilic polymer so that it is not clear whether or not the specific ranges of proportions set forth in applicants' claims are met. However, note in the Examples section not only the Examples 44-46, but the list of ingredients beginning the Examples Section for not only the acrylic adhesive but also the

surfactants and suspending agents which read upon ingredients in applicants' claimed genus of articles, together with the fact that the various adhesive compositions can be coated on a suitable substrate. With respect to the layered structures of claims 5 and 6, as noted earlier, no layered relationship is believed to be necessary to meet the parameters of claim 5, as previously pointed out, and with respect to claim 6 to have an amount of 3 parts by weight of anionic emulsifier containing a sulfur atom for both the outer adhesive layer and also the remainder of the adhesive composition is believed to be an obvious modification to one of ordinary skill, in the absence of unexpected results.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the PG pubs to Tosaki et al., U.S. 2003/0162886, U.S. 2005/0075444, and U.S. 2004/0091689, the latter being the PG pub for the present application, and it is also noted that each of these has as inventors each of the three co-inventors of the present application. Additionally, note also Kassner, Hauber, and GB 1409594.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

June 14, 2005

**DANIEL ZIRKER
PRIMARY EXAMINER**

Daniel Zirker